

REMARKS

The Examiner has withdrawn the previous 35 U.S.C. §103 rejections of claims 1 - 8, 10 - 20, and 22 over Huddleston et al (U.S. Pat. No. 5,653,472) in view of Haas (U.S. Pat. No. 5,785,354) and Attia et al (U.S. Pat. No. 6,016,618), and claims 9 and 21 over Huddleston et al in view of Haas, Attia et al and Charles et al (U.S. Pat. No. 4,318,234). In place of the withdrawn rejections, the Examiner now rejects claims 1 - 8, 10 - 20 and 22 under 35 U.S.C. §103(a) as unpatentable over Huddleston et al in view of Haas and newly cited Wiebe (U.S. Pat. No. RE30,786). Claims 9 and 21 are also rejected under 35 U.S.C. §103(a) as unpatentable over Huddleston et al in view of Haas and Wiebe, as applied to claims 1 - 8, 10 - 20 and 22, above, and further in view of Charles et al.

Independent claim 1, amended to correct a typographical error, and claim 13 read as follows:

1. A patient wristband form, comprising:

a transparent ply having an upper surface and a lower surface,

a pressure sensitive adhesive coating on said lower surface of said transparent ply,

a release ply having an upper surface and a lower surface, said release ply having a release coating on said upper surface of said release ply, said transparent ply being removably mounted on said upper surface of said release ply by said pressure sensitive adhesive coating,

a die cut in said transparent ply defining an elongated wristband,

an opaque coating on said upper surface of said transparent ply in a central portion of said elongated wristband, and

a die cut in said transparent ply defining an overlamine label, said overlamine label being separate from said elongated wristband and sized to cover at least a part of said central portion of said elongated wristband so as to cover indicia printed on said opaque coating.

13. A patient wristband form, comprising:

a top ply having at least a portion which is **substantially transparent** and **a portion which is not substantially transparent**, said top ply having an upper surface and a lower surface,

a pressure sensitive adhesive coating on said lower surface of said top ply,

a release ply having an upper surface and a lower surface, said release ply having a release coating on said upper surface of said release ply, said top ply being removably mounted on said upper surface of said release ply by said pressure sensitive adhesive coating,

a die cut in said top ply defining an elongated wristband, said wristband including at least part of said portion of said top ply which is not substantially transparent, whereby a print indicia receiving area is defined in a central portion of said elongated wristband, and

a die cut in said transparent portion of said top ply defining an overlamine label, said overlamine label being separate from said elongated wristband and sized to cover at least a part of said print indicia receiving area.

These claims distinguish the present invention from the prior art and clearly define the invention. The primary reference, Huddleston, is missing all of the elements shown with bold type, above, and a number of the other claim elements that are brought in by the dependent claims.

The Examiner admits that the principal reference relied upon, Huddleston, is deficient in a number of aspects in meeting the terms of the claims. Specifically the Examiner has indicated that Huddleston does not show a form with: 1.) a transparent ply; 2.) a die cut in the transparent ply defining an overlamine label; 3.) the overlamine label being separate from the wristband; 4.) an opaque coating on the upper surface of the transparent ply in a central portion of the wristband defined by the transparent ply; 5.) the opaque coating defining a coating of a white, opaque ink; 6.) the overlamine label being sized to cover at least a part of the central portion of the wristband so as to cover indicia printed on the opaque coating; 7.) the transparent ply

comprising a ply of substantially clear polyester material; and 8.) a perforation line extending across the transparent ply between the top ply and the paper ply. The Examiner adds Haas and Wiebe to Huddleston to address these short comings.

The reasons given for combining the references are clearly makeweight, and mischaracterize the nature of the references to facilitate their combination. The Examiner has again indicated that the combination of Huddleston and Haas would have been obvious "in order to have a surface that is capable of absorbing ink to form a display as taught by Haas and to have a laminated article that protects the printed material from unauthorized tampering." This relies upon a distortion of the teachings of Haas, as explained below. Additionally, the Examiner offers absolutely no reason why a person of ordinary skill in this area of technology would combine the teachings of Huddleston and Haas with the teachings of Wiebe. There is simply no reason given for adding Wiebe to the other references, not even a makeweight reason. As such, this combination of references is clearly impermissible.

Additionally, as pointed out, above, the Examiner misconstrues Haas. Haas teaches a "self-expiring identification band" which has a an "EXPIRED" message that bleeds through an opaque adhesive layer. The "EXPIRED" message can then be viewed through a covering transparent layer on the wristband. Haas does not contemplate the printing of a message on an opaque ink or any other opaque layer. Rather, the message in Haas is printed on a separate layer, and then brought into contact with the under-side of the opaque adhesive layer when the band of Haas is attached to the wearer's wrist. This begins the bleed-through process that is designed to produce an "expired" wristband at the end of the timed bleed through. See Figs. 3 - 7 of Haas. The printed message then migrates through the opaque adhesive in Haas for viewing (Fig. 6) after the band has been on the wearer's wrist for a preset period of time. Haas simply does not print on the opaque coating, as called for in the claims.

The combination of Huddleston, Haas, and Wiebe is made possible in the Office Action only through a hindsight review of the references. That is, the Examiner has effectively used the claims of the present application as the roadmap for the combination. The Examiner asserts that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." The Examiner cites *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)

for this proposition, stating that as long as the rejection does not include "knowledge gleaned only from the applicant's disclosure, such reconstruction is proper." What applicants have pointed out here is that the Examiner is not entitled to use a claim as a shopping list of elements, and then dig through the prior art to find and combine the claim elements from the diverse prior art references.

Applicants' position regarding combination of references in an obviousness rejection is legally correct, and *In re McLaughlin* is not contrary to applicants' position. It is not permissible for the Examiner to use the invention itself, as delineated in the claims, as the template to find individual pieces in the prior art and then to declare the invention to be obvious based on a combination created only through such hindsight. The United States Supreme Court addressed the proper standards to combine references in a 35 U.S.C. §103 situation, in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 167 L.Ed.2d 705, 82 USPQ2d 1385 (2007).

The Supreme Court disapproved the Federal Circuit's strict "TSM" test (teaching, suggestion or motivation) for determining whether it is obvious to combine references under 35 U.S.C. §103, and adopted a subjective standard in which all of the facts and circumstances associated with the invention and the prior art are considered. The Supreme Court cited with approval however, several recent Federal Circuit cases in which the Federal Circuit adopted a more flexible TSM standard.

As indicated by Margaret A. Forcarino in her May 3, 2007 to the Technology Center Directors, the Supreme Court reaffirmed the standards for obviousness set out in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966): a.) determining the scope and contents of the prior art; b.) ascertaining the differences between the prior art and the claims; c.) resolving the level of ordinary skill in the pertinent art; and d.) evaluating evidence of secondary consideration. Judged against this standard, the claimed invention is not obvious. The teachings of the references simply cannot be combined without some articulated reason.

It is applicants' view that under the *Graham* subjective standard for obviousness, the present invention is not obvious over the cited prior art. The Examiner has misconstrued the Haas reference, as pointed out above, and the Examiner has also misconstrued the Wiebe reference. Wiebe shows a wristband that includes a pressure sensitive layer within the multiple

layers that make up the band. A typewriter or similar device is used to print indicia by applying pressure through the multiple layers to change the color of the middle layer. Wiebe does not have an exposed layer which can be imaged with a non-contact printer and then covered with an overlamine label or cover layer, as suggested by the Examiner. The die cuts that the Examiner points to in the Office Action as defining the overlamine label in Wiebe are lines of weakness 16, 17, and 18. These lines of weakness do not define an overlamine label. In actuality, lines of weakness 16, 17, and 18 simply allow each of the wristbands to be separated from adjacent wristbands. There are no separate overlamine labels in Wiebe that can be applied to a wristband after an area that has an opaque coating is printed.

Further the Examiner has given no reason why a person of ordinary skill would combine the teachings of Wiebe with those of Huddleston and Haas. With absolutely no reason to combine the references, any combination must necessarily be an impermissible hindsight combination, and the rejection not sustainable on this basis.

The rejection of claims 9 and 21 is flawed for the same reason as the rejection of the balance of the claims. While the Charles patent is added to the combination of Huddleston, Haas, and Wiebe for a teaching of a mechanical clasp for holding a wristband in place, it does nothing to cure the defects that are pointed out above in the combination of Huddleston, Haas, and Wiebe.

It is submitted that all of the claims are in condition for allowance. Early notice of favorable action is respectfully requested.

Respectfully submitted,
DINSMORE & SHOHL L.L.P.

By /James F. Gottman/
James F. Gottman
Registration No. 27,262

One Dayton Centre
One South Main Street, Suite 1300
Dayton, Ohio 45402-2023
Telephone: (937) 449-6400
Facsimile: (937) 449-6405
e-mail: james.gottman@dinslaw.com